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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Art Unit: 1794

**NOTE**

1. Applicants argue at Remarks page 16:

“Claim 181 - Referring to the last three paragraphs, separate sheet portions are claimed and the lower bottom-most surfaces of both of the separate sheet portions are formed by the lower bottom-most surface of the sheet structure. This is not taught by Mihara nor has the examiner pointed out how it is taught.”

However, the term “separate sheet portions” is *literally* interpreted as defining *individual areas or portions* of the sheet. Absent a limitation that these sheet portions are separated apart from each other, the examiner maintains that the prior art reads on the invention as claimed. Similarly applicants’ arguments over the remaining independent claims are unpersuasive.

2. Applicants argue at page 17:

“Mihara is not relevant to the present claims which describe the structural properties of Applicant's sheet which splits when bent. The claims do not mention that the sheet splits when cut. Referring to Dr. Ugolick's Declaration quoted above, Mihara does not split when bent. Whether or not it splits when cut is not relevant.”

However, as stated in the Final action mailed 12/24/2008, page 2:

“in the absence of what is the intended scope of the term "split", the examiner maintains that the prior art reference Mihara anticipates all the limitations as claimed, because inherently at least bending Mihara's multilayered sheet upwardly on the half cut line 2 necessarily renders layers 6-8 (*a portion thereof*) "split" apart at the half cut, *even if layer 5 is not break or split*.”

3. Applicants argue at page 18:

“the scope of the term "split" is clear from the description of the "sheet portions" in the last two paragraphs of claim 181, from the last two paragraphs of claim 200, the last paragraph of claim 223, and the last two paragraphs of claim 242. Applicant's sheet has structural properties to split from the bottom end of the cut to the bottom surface of the sheet when bent on the cut line to separate the sheet into two separate portions.”

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However, the underlined description is absent from the claimed limitations. The examiner maintains that absent the scope of the “split”, Mihara reference reads on the instant invention as claimed. Since the claim language fails to exclude prior art, applicants may wish to clarify the intended scope of the claimed invention in the next reply.

4. Applicants argue at page 19:

“it is not clear whether the rejections in the prior Office Actions are being repeated or not. If they are being repeated, then the examiner must respond to Applicant's arguments in his last Amendment (pages 17-34). See MPEP 707.07(f) which says that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.” (Emphasis added.) If the rejections in the prior Office Actions have been withdrawn then the rejections in this Final Office Action must be fully set forth, and where and how each of the claim elements in each of the independent (and dependent) claims are suggested by Mihara must be fully explained. Applicant should not be forced to pick and choose which aspects of the rejections in the prior Office Actions are being maintained and which are not being maintained to create the examiner's new rejections.”

However, the Office action mailed 12/4/2008 clearly stated at page 2:

“The grounds of rejections are maintained for the same structural features anticipated by Mihara, as set forth in prior Office actions mailed 6/3/2008 and 5/3/2007.”

5. Applicants argue at page 19:

“the examiner did not respond to Applicant's request in the paragraph bridging pages 17 and 18 of the last Amendment that the examiner include specific MPEP citations and other explanations for any further rejections which use the term “use step” (and other terms). Those requested citations and explanations were not provided in the subject Final Office Action.”

However, since the functional language has been considered in the Final action mailed 12/4/2008, the request is moot. Nevertheless, the examiner notes that since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

6. Applicants argue at page 20:

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“Referring to section IC above, the examiner raised a new issue that the intended scope of "split" is unknown. Accordingly, the subject Office Action should have been a non-final Office Action.”

However, nowhere has the examiner made a 112, 2<sup>nd</sup> rejection. The examiner merely points out the position taken by the examiner in previous Office actions. Again, applicants may wish to further clarify the intended scope of the claimed invention in the next reply, so as to exclude the relied upon prior art reference.